

DETAILED ACTION

Review of 1.131 Affidavits

1. The affidavit filed on February 14, 2008 under 37 CFR 1.131 has been considered but is ineffective to overcome the Shirakihara reference.
2. The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country before the effective date of the Shirakihara reference.
3. An effective affidavit under 37 C.F.R 1.131 has two components: 1) an indication of basis for the affidavit and 2) accompanying evidence to the support the affidavit. Upon review, the affidavit filed on February 14, 2008 is deficient in at least one area. The evidence provided uses the screen shots from the interview on May 17, 2007 which the inventors and Applicant's representatives were provided. However, these screenshots cannot be used to substantiate Applicant's claim of possession of the inventive subject prior to the date of the Shirakihara reference (e.g. June 7, 2007) unless the screenshots are "original exhibits". The affidavits appear to lack information as to the origin of the screenshots.
4. Applicant argues – "Thus, it is respectfully submitted that it is clear that the applicants are using actual reduction to practice in this country as the basis of their declarations. Moreover, it is noted that the examiner acknowledged that point during the interview on May 7, 2008."

- a. In the interview, applicant pointed the examiner to paragraph 19 of the Gene Eggleston and Mitch Hansen affidavits along with paragraph 21 of the affidavit by Richard Krebs filed February 14, 2008. None of the affidavits use the terms "actual" or "conceptional" reduction to practice, therefore, the examiner is left to wonder which basis applicant is using. This is a weakness of applicant's affidavit, the examiner relies on the fact that applicant is using the code as evidence to determine that the basis is actual reduction to practice.
5. Applicant argues – "In response, it is respectfully submitted that the screen shots were made (just prior to the previous interview) from the programs generated and used successfully prior to the critical data of the Shirakihara reference. That is, they are equivalent of recently made photographs of a device made and tested prior to the critical data of a reference."
- b. Recently made photographs of a device would provide evidence the device exists but not how the device operates. In the case of the present application, the screenshots must contain content that was available prior to the critical date. Because the content is descriptive, the descriptive information must have been compiled prior to the critical date. If applicant possessed "original exhibits" including descriptive content and then encapsulated that content in the screenshots then the presented affidavit would be sufficient. However, absent "original exhibits" applicant could map the functions to the underlying code or software modules.

Allowable Subject Matter

6. Claims 56-63, 65 are allowed.
7. The following is an examiner's statement of reasons for allowance: Claims 56-63 and 65 are allowable over the prior art of record in light of applicant's arguments filed on May 13, 2008 from page 3, the second to last line through page 4, line 13. Specifically applicant's argument that Mullan's message transfer agent converts an internally meaningful address to an externally meaningful address and the external address is not the host address or the first address as claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 2145

2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
10. Claims 33-34, 40-47, 54-55 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakihara et al., USPN 5,941,956 (hereafter referred to as Shirakihara) in Perkins, USPN 5,159,592 (hereafter referred to as Perkins).
11. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakihara and Perkins as applied to claim 34 above, and further in view of Dunn, USPN 5,659,596 (hereafter referred to as Dunn).
12. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakihara and Perkins as applied to claim 33, above, and further in view of Pepe.
13. Claims 48-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirakihara as applied to claim 33 above, and further in view of Pepe.
14. Claims 66-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe in view of Dunn.
15. Regarding claim 33, Shirakihara taught a method of forwarding messages between a host system and a mobile client (abstract), comprising the steps of:
- establishing a session based on loaded parameters at the host system (column 8, lines 3-13);
 - querying the host system (column 8, lines 3-13);
 - receiving messages directed to a first address at the host system from a plurality of message senders (column 7, lines 34-41; column 8, lines 14-18);

in response to a query, continuously forwarding the messages from the host system to the mobile client (column 8, lines 21-44);

generating reply messages at the mobile client to be sent to the plurality of message senders and transmitting the reply messages to the host system (column 8, lines 48-53);

receiving the reply messages at the host system and configuring the reply messages such that it will appear to the plurality of message senders that the reply messages originated at the first address associated with the host system (Response message M(A1,a2) sent to conversion device 3-2 and becomes M(A1,A2). Response message M(A1,A2) sent to conversion device 3-1 and becomes M(a1, A2).); and

transmitting the reply messages from the host system to the plurality of message senders (column 8, lines 48-53). Shirakihara does not specifically teach maintaining the session at host system. However, Perkins taught maintaining the session at the host system (column 3, lines 63-68; column 6, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Perkins's step of maintaining the session in Shirakihara's method for forwarding messages would have would have improved reliability. The motivation would have been to ensure packets are routed to migrating mobile clients (Perkins, column 2, lines 65-66).

16. Regarding dependent claim 34, Shirakihara taught the method further comprising the step of: storing information regarding the configuration of the mobile client at the host system (column 8, lines 7-13).

17. Regarding dependent claim 35, Shirakihara taught the configuration information stored at the host includes (A) the network address of the mobile client (column 8, lines 7-13). Shirakihara does not specifically teach the host include (B) an indication of the types of the message attachments that the mobile client will receive and process. However, Dunn taught a host includes (B) an indication of the types of the message attachments that the mobile client will receive and process (column 15, lines 17-23; column 19, lines 27-32). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Dunn's message type in Shirakihara-Perkins method of forwarding messages would have improved system robustness. The motivation would have been to route messages to roaming target users without the message senders needing to have detailed information about the mobile client (Dunn, column 1, lines 9-16).

18. Regarding dependent claim 36, Dunn taught the configuration information further includes: (C) an indication of the protocol of the mobile client (column 22, lines 46-59).

19. Regarding dependent claim 37, Shirakihara-Perkins does not specifically teach whether the messages include an attachment. However, Dunn taught a method for forwarding messages further comprising the steps of:

for each message to forwarded, the host system determining whether the message includes an attachment, and if so then determining the type of attachment (column 23, lines 40-42);

accessing the stored configuration information at the host system to determine whether the mobile client will receive and process attachments of the determined type (column 23, lines 40-47); and

if so, then forwarding the attachments to the mobile client (column 30, lines 40-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Dunn's message type in Shirakihara-Perkins method of forwarding messages would have expanded system flexibility by including more message types. The motivation would have been to route messages to roaming target users without the message senders needing to have detailed information about the mobile client (Dunn, column 1, lines 9-16).

20. Regarding dependent claim 38, Dunn taught the type of attachment is a sound file (column 15, lines 15-17).

21. Regarding dependent claim 39, Shirakihara taught the received messages are address using a sender address and a receiver address (column 7, lines 53-57), the method further comprising the steps of:

determining whether the receiver address is associated with the mobile client (column 8, lines 14-29);

if the receiver address is associated with the mobile client, then determining a network address of the mobile client and packetizing the messages using the receiver address and the network address of the mobile client (column 8, lines 14-29); and

after receiving the forwarded messages at the wireless subscriber unit, so that it appears as though the mobile client is the host system (column 8, lines 45-53).

Shirakihara-Perkins does not specifically teach displaying the messages at the mobile client using the sender address and the receiver address. However, Pepe taught displaying the messages at the mobile client using the sender address and the receiver address (column 18, lines 1-6). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Pepe's displaying messages in Shirakihara-Perkins' system for forwarding messages would have provided an equivalent mechanism for viewing messages. The motivation would have been to allow the receiver to access forwarded messages.

22. Regarding dependent claim 40, Shirakihara taught the parameters of the established session at the host system include external events (column 8, lines 3-13) or internal events (column 8, lines 8-13). Perkins taught the parameters of the established session at the host system include network events (column 6, lines 8-18).

23. Regarding dependent claim 41, Shirakihara taught the external event is a registration message from the mobile client (column 8, lines 3-13).

24. Regarding dependent claim 42, Shirakihara taught the internal event is an execution of control messages (execution of response registration messages, column 8, lines 3-13).

25. Regarding dependent claim 43, Shirakihara the internal event is an execution of programs (programs to respond to registration, column 8, lines 3-13).

26. Regarding dependent claim 44, Perkins taught the internal event is a timer operation (column 5, lines 34-42).

27. Regarding dependent claim 45, Perkins taught the networked events include messages to begin forwarding from computer systems other than the mobile client, which are connected to the host system via wired network (column 6, lines 8-18).

28. Regarding dependent claim 46, Shirakihara taught the mobile client is a mobile station (column 7, lines 34-41).

29. Regarding dependent claim 47, Dunn taught the mobile client is a device equipped to receive both voice and non-voice data messages (column 15, lines 17-23).

30. Regarding dependent claim 48, Shirakihara-Perkins does not specifically teach the host system includes a client profile database limiting the forwarding step to forwarding only those messages that are transmitted to the host system from a sender stored in the database. However, Pepe taught a host system includes a client profile database limiting the forwarding step to forwarding only those messages that are transmitted to the host system from a sender stored in the database (column 5, lines 45-54; column 6, lines 48-59). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Pepe's client profile database in Shirakihara-Perkins' system for forwarding messages to mobile clients would have improved system robustness. The motivation would have been to reduce the consumption of system resources by not sending unwanted messages.

31. Regarding dependent claim 49, Pepe taught a user can add and subtract senders from the database (column 27, lines 9-12).

32. Regarding dependent claim 50, Pepe taught a user can add and subtract senders from the database by configuring the host system (column 27, lines 15-24).

33. Regarding dependent claim 51, Pepe taught a user can add and subtract senders from the database by transmitting a command message from the mobile client to the host system (column 27, lines 15-24).

34. Regarding dependent claim 52, Pepe taught an active client profile database is activated and deactivated at the host (column 6, lines 47-59; column 26, lines 43-47).

35. Regarding dependent claim 53, Pepe taught an active client profile database is activated and deactivated from the mobile client (column 26, lines 43-47).

36. The language of claims 54-55, 64 is substantially the same as previously rejected claim 33, above. Therefore, claims 54-55, 64 are rejected on the same rationale as previously rejected claim 33, above.

37. Regarding dependent claim 66, Pepe does not specifically teach maintaining the session. However, Dunn taught a method of forwarding message comprising the steps of:

establishing a session with the host system based on loaded parameters (column 9, lines 51-55);

maintaining the session with the host system and querying the host system (column 9, lines 46-51);

continuously forwarding the received messages from the host system to the wireless mobile client associated with the host system (column 17, lines 46-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made Dunn's maintaining a session in Pepe's system for forwarding messages would

improved system robustness. The motivation would have been to reduce the number of messages are lost to being out of range.

38. Regarding dependent claim 67, Pepe taught the session is an execution of programs (column 16, lines 1-11).

39. Regarding dependent claim 68, Pepe taught a method further comprising the steps of:

loading parameters at the host system (column 16, lines 1-11);

filtering received messages at the host system using one or more message filter prior to forwarding messages to the wireless mobile client (column 10, lines 33-43).

Conclusion

40. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2145

41. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 571-272-3935. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrice Winder/
Primary Examiner, Art Unit 2145

August 8, 2008